

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL A. JOHNSON, CLAYTON A. GEORGE, PEGGY S. WILLETT
and SCOTT R. MEYER

MAILED

JAN 30 2001

Appeal No. 1997-3870
Application No. 08/421,055

PAT & TM OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

ON BRIEF

Before PAK, WALTZ and LIEBERMAN, *Administrative Patent Judges*.

WALTZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 6 through 32 as amended subsequent to the final rejection (see the amendments dated Aug. 26, 1996, Paper No. 11, and Nov. 25, 1996, Paper No. 14, entered as per the Office action dated Sep. 12, 1996, Paper No. 12, and the Advisory Action dated Dec. 19, 1996, Paper No. 16, respectively). Claims 6 through 32 are the only claims remaining in this application.

According to appellants, the invention is directed to a method for modifying the surface of a substrate by use of an article comprising a melt-flowable composition and a

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dimensionally stable film (Brief, pages 1-2). Claim 6 is illustrative of the subject matter on appeal and a copy of this claim is attached as an Appendix to this decision.

The examiner has relied upon the following references as evidence of obviousness:

Wagner et al. (Wagner)	3,837,984	Sep. 24, 1974
Pletcher	4,059,715	Nov. 22, 1977
Kan	4,631,233	Dec. 23, 1986
Schappert et al. (Schappert)	4,822,683	Apr. 18, 1989

Claims 6 through 32 stand rejected under 35 U.S.C. § 112, ¶1, for lack of support in the disclosure (Answer, page 4). Claims 14-15 and 29-31 stand rejected under 35 U.S.C. § 112, ¶1, as not completely enabled by the disclosure (*id.*). Claims 6-8, 16, 20-26 and 32 stand rejected under 35 U.S.C. § 102 as anticipated by or, in the alternative, under 35 U.S.C. § 103 as unpatentable over Wagner (*id.*). Claims 10-13 stand rejected under section 103 as unpatentable over Wagner in view of Pletcher (*id.*). Claims 9 and 28 stand rejected under section 103 as unpatentable over Wagner in view of Schappert (Answer, page 5). Claims 17-19 and 27 stand rejected under section 103 as unpatentable over Wagner in view of Kan (*id.*).

We affirm the examiner's rejection under § 112, ¶1, as the claims are "not (completely) supported by the disclosure"

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(Answer, page 4) but reverse all of the other rejections for reasons which follow.

OPINION

A. *The Rejections under 35 U.S.C. § 112, ¶1*

The examiner has first rejected the claims on appeal under 35 U.S.C. § 112, first paragraph, "as being not (completely) supported by the disclosure."¹ *Id.* We note that the language of this rejection is equivalent to stating that appellants' disclosure fails to meet the "written description" requirement of 35 U.S.C. § 112, ¶1. See *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1560, 19 USPQ2d 1111, 1114 (Fed. Cir. 1991).

The examiner finds that there is no apparent support in the original disclosure for the claimed limitation requiring the dimensionally stable film to have a preselected surface topography, i.e., "said film having a pre-selected surface topography" (Answer, page 6; claim 6, part (a)).

Appellants agree that the exact language used in the claims "does not necessarily appear in the specification." Brief, page

¹ We note that appellants state "[t]he rejected claims stand or fall together." Brief, page 6. In view of this statement and the provisions of 37 CFR § 1.192(c)(7)(1995), we select claim 6 from the grouping of claims and decide this appeal as to this ground of rejection on the basis of this claim alone.

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13. However, appellants argue that the specification, when read as a whole, including page 7, ll. 8-17, page 27, ll. 17-19, and page 28, ll. 9-22, demonstrates applicants' recognition that in certain instances it is desirable to provide an article having a smooth surface or an article having a predetermined design on its surface (*id.*).

Ipsis verbis disclosure is not necessary to satisfy the written description requirement of 35 U.S.C. § 112. The disclosure need only reasonably convey to those of ordinary skill in the art that the inventors had possession of the subject matter in question. *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1570, 39 USPQ2d 1895, 1904 (Fed. Cir. 1996). We agree with the examiner that appellants' disclosure does not reasonably convey to one of ordinary skill in the art that appellants had possession of "said [dimensionally stable] film having a pre-selected surface topography" as recited in claim 6 on appeal.

Appellants' citation of supporting disclosure (Brief, page 13) is not persuasive. The disclosure at page 27, ll. 17-19, of the specification merely states that the dimensionally stable film "can be used to provide smooth surfaces...." The examiner agrees that the films can be used on smooth surfaces (Answer, page 6). The disclosure at page 28, ll. 9-22, only sets forth

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the definition and properties of dimensionally stable films but does not disclose anything about the pre-selected topography. The disclosure at page 7, ll. 8-17, is concerned with emblems or insignia. However, this disclosure is directed to the "sheet material" which has previously been defined as the melt-flowable sheet material or composition, not the dimensionally stable film (see the specification, page 7, ll. 13-15; and the definition of "melt-flowable sheet material" on page 6, ll. 10-21). Appellants specifically argue that a "melt-flowable composition" is defined in the specification at page 6, ll. 15-21 (Brief, page 3). We determine that the disclosure at page 7 is relevant to melt-flowable sheet material but fail to find any basis for the pre-selected surface topography of the dimensionally stable film. Accordingly, we determine no reversible error in the examiner's findings and affirm the rejection of claim 6 through 32 under 35 U.S.C. § 112, paragraph one, for failure to meet the "written description" requirement.

The examiner has rejected claims 14, 15 and 29-31 under 35 U.S.C. § 112, ¶1, as "not completely enabled by the disclosure." Answer, page 4. As noted in *Vas-Cath Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1117, the written description requirement of 35 U.S.C. § 112, ¶1, is separate and

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distinct from the enablement requirement. "To be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation.'" *In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). Whether making and using the invention as claimed would have required undue experimentation is a legal conclusion based upon several underlying factual inquiries. See *In re Wands*, 858 F.2d 731, 735-37, 8 USPQ2d 1400, 1402-04 (Fed. Cir. 1988).

The examiner finds that the specification, at page 27, ll. 10-22, clearly indicates that epoxy-polyester blends must be fully thermoset/crosslinked when employed as a dimensionally stable film (Answer, page 6). Appellants argue that the claimed word "thermosetting" refers to compositions which are not completely set, as used in the art and the specification (Brief, page 14). Appellants cite page 29, ll. 23-27, of the specification, for the disclosure of optional curing of dimensionally stable films (Brief, page 15).

We determine that the examiner has not met the initial burden of establishing why one of ordinary skill in the art could not practice the subject matter as claimed without undue experimentation. The examiner has not made the necessary factual

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findings to support a legal conclusion of lack of enablement.² Appellants' specification, at page 27, ll. 10-22, does not disclose that it is critical that the epoxy-polyesters be crosslinked when used as dimensionally stable films but only teaches crosslinked epoxy-polyesters as *examples* of thermoset films. Additionally, as argued by appellants, the disclosure teaches optional curing of films, although these films are in combination with other components (specification, page 29, ll. 16-27).

For the foregoing reasons, we determine that the examiner has not presented the underlying factual inquiries to support his

² We again note the difference in the written description and enablement requirements of section 112. See *Vas-Cath, supra*. Although we determine that the examiner here has not met the initial burden of establishing that the disclosure lacks enablement, this does not mean that the claimed subject matter is based on sufficient written description in the original disclosure. In the event of further or continuing prosecution of this application, the examiner and applicants should determine whether the "written description" requirement of section 112 has been fulfilled for the subject matter of claims 14, 15 and 30, i.e., whether there is sufficient basis in the original disclosure to reasonably convey to one of ordinary skill in the art that applicants had possession of the subject matter of these claims.

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legal conclusion. Accordingly, the examiner's rejection of claims 14, 15 and 29-31 under 35 U.S.C. § 112, first paragraph, is reversed.

B. The Rejections under 35 U.S.C. § 103

Claim 6 on appeal requires that a melt-flowable composition contacts the surface of the substrate and, upon heating, flows over and substantially covers a desired area of said surface to adhere the article to said surface (see claim 6, parts (a) and (b)). The sole or primary reference in every rejection advanced by the examiner is Wagner, who teaches a thermoplastic adhesive with a support layer of polyurethane where the dried nitrile phenolic adhesive composition "will soften to cause adhesion" when heat is applied (Wagner, abstract, col. 1, ll. 13-17). Therefore Wagner fails to disclose or teach the claimed limitation that the melt-flowable composition upon heating flows over and substantially covers the surface of the substrate.

The examiner recognizes that Wagner only discloses "a heat softenable adhesive" (Answer, page 5). In response to appellants' argument that Wagner merely discloses a heat softenable adhesive that does not flow and wet the surface (Brief, pages 8-9), the examiner finds that "the thermosetting adhesive employed by these patentees [Wagner] is held/seen to be

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initially advanced to no further than B-stage (which is held/seen to indicate/provide for the occurrence of at least some flow at elevated temperature, prior to the attainment of full (ie [sic] C-stage) cure)." Answer, page 7. However, the examiner fails to cite any evidence or reasoning to support this last finding. Accordingly, we determine that Wagner fails to disclose or suggest a melt-flowable composition as required by claim 6 on appeal. Furthermore, we agree with appellants that the adhesive of Wagner could not be employed for its intended use if the adhesive composition was melt-flowable (Brief, page 9; see Wagner, col. 5, ll. 4-22 and Figure 7).

Pletcher, Schappert and Kan have been applied by the examiner to show the conventionality of various features recited in dependent claims (Answer, pages 5-6). Accordingly, these secondary references do not remedy the deficiency in Wagner as discussed above.

For the foregoing reasons, we determine that the examiner has not provided a factual basis to show that every limitation of the claims is disclosed or taught by Wagner. Thus the rejection under 35 U.S.C. § 102 cannot be sustained. See *In re Bond*, 910 F.2d 831, 832, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990). Similarly, we determine that the examiner has not provided a factual basis

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sufficient to support a *prima facie* case of obviousness. Thus the rejections under section 103 cannot stand. *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967).

C. Summary

The rejection of claims 6-32 under 35 U.S.C. § 112, ¶1, for failure to fulfill the written description requirement is affirmed. The rejection of claims 14, 15 and 29-31 under the first paragraph of 35 U.S.C. § 112 for lack of enabling disclosure is reversed.

The rejection of claims 6-8, 16, 20-26 and 32 under 35 U.S.C. § 102 as anticipated by or, in the alternative, under 35 U.S.C. § 103 as unpatentable over Wagner is reversed. The rejection of claims 10-13 under 35 U.S.C. § 103 as unpatentable over Wagner in view of Pletcher is reversed. The rejection of claims 9 and 28 under 35 U.S.C. § 103 as unpatentable over Wagner in view of Schappert is reversed. The rejection of claims 17-19 and 27 under 35 U.S.C. § 103 as unpatentable over Wagner in view of Kan is reversed.

The decision of the examiner in rejecting the claims on appeal is thereby affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

CHUNG K. PAK
Administrative Data

CHUNG K. PAK
Administrative Patent Judge

THOMAS A. WALTZ
Administrative Patent Judge

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APPENDIX

6. A method for modifying the surface of a substrate comprising the steps of:

(a) placing on said surface an article comprising (i) a melt-flowable composition and (ii) a dimensionally stable film for controlling the melt-flow behavior of said melt-flowable composition, such that said melt-flowable composition contacts said surface,

said film having a pre-selected surface topography;

(b) heating said article to cause said melt-flowable composition to flow and substantially cover a desired area of said surface to adhere said article to said surface,

said dimensionally stable film controlling the melt-flow behavior of said melt-flowable composition to substantially confine said melt-flowable composition to said desired area of said surface; and

(c) allowing said article to cool while substantially retaining said pre-selected surface topography of said film.